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Remarks

This paper is in response to the Official Action dated September 17, 2004, for the above-identified application. A response to the office action was originally due on December 17, 2004. Applicants are filing this response with a request for a two-month extension of time, thus making this paper timely if sent on or before the new filing date of February 17, 2005.

Claims 1-30 are pending in the application. Claims 27-30 have been withdrawn from consideration. Claims 1, 18, 19 and 21 have been rejected. Claims 2-17, 20 and 22-26 are objected to. Applicants have amended claims 1, 2, 4, 6, 14, 18, 19, 21 and 22. Claims 23, 24, 27-30 have been canceled. No new subject matter has been added to the subject application with the filing of this response. Applicants reserve their right to file divisional applications on the subject matter that has been subject to restriction and continuation applications on the subject matter that has been deleted out of all currently amended claims.

Restriction Requirement

The Examiner stated that the applicants' election with traverse of group I is acknowledged. The Examiner maintained the restriction based on a search of the art based on applicants' core. The Examiner stated that if the compounds were to be found allowable, then the method of treating claims of group II, claims 18, 19, 21-26, limited to the scope of the allowable compounds would be rejoined.

In response, applicants have amended claim 1 as suggested by the Examiner in the June 3, 2004 restriction requirement, so that claim 1 is directed to group I — type compounds where n is 0, r is 1 and Y is $(CR_2, CR_3)_pC(O)-NH-$. However, applicants maintain that Ar and R^4 should not be limited specifically to aryl but should also include substituted aryls. Applicants respectfully suggest that since n , R and Y have been limited as the Examiner has suggested, it would be no longer burdensome to search for compounds where Ar and R^4 are substituted or non-substituted aryls. Further, applicants, were they to limit Ar and R^4 to merely aryl, would be denied the right to claim compounds they have disclosed to in the specification and in claim 16, such as substituted aryl groups. Lastly, applicants

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respectfully point out that R^1 as defined in the original claim 1, is based on the different types of groups that are found in the compounds of claim 16. Therefore, applicants respectfully ask that the Examiner consider the applicants' suggestions to modify group I from the Restriction Requirement of June 3, 2004.

35 USC §112, First Paragraph

The Examiner stated that claims 1 is rejected under 35 U.S.C. 112, first paragraph, because the Examiner believes that the specification, while being enabling for 1 to 3 R^6 substituents, does not reasonably provide enablement for R^6 to be number 4 or 5 substituents.

In response, as required by the Examiner, applicants have amended claim 1 so that it is now limited to 1 to 3 R^6 substituents. Applicants therefore, respectfully request the withdrawal of this rejection.

35 USC §112, Second Paragraph

The Examiner stated that claims 18, 19 and 21 are rejected under 35 U.S.C. 112, second paragraph, because the Examiner believes that the recitation of metabolic disorders or eating disorders are reach through claims, and are therefore indefinite.

In response, applicants have amended claims 18, 19, 21 and 22 so that they are now directed to hyperphagia and obesity. Support for this amendment can be found in originally filed claims 23 and 24, which have been canceled with the filing of this amendment. Applicants therefore, respectfully request the withdrawal of this rejection.

Allowable Claims

The Examiner stated that while claims 1, 18, 19 and 21 were not found to be allowable, the Examiner believed they would be allowable should the applicants amend said claims to overcome the existing §112 rejections.

Applicants respectfully submit that in view of the above response, applicants have sufficiently addressed the Examiner's rejections, objections and that the application, as amended, is in condition for allowance.

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If any additional fees, other than the appropriate extension of fees, are determined to be due by this paper, the Commissioner is hereby authorized to deduct such fees from **Account No. 19-0365**.

The Examiner is requested to call the undersigned attorney on any matter connected with this application.

Respectfully submitted,
SCHERING-PLOUGH CORPORATION

By: 

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